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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,239	09/28/2005	Harald Schwahn	278349US0PCT	4258
22850	7590	08/06/2009		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
HINES, LATOSHIA D				
ART UNIT		PAPER NUMBER		
1797				
NOTIFICATION DATE		DELIVERY MODE		
08/06/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/551,239

Applicant(s)

SCHWAHN ET AL.

Examiner

LATOSHA HINES

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This is the final office action based on the 10/551239 application filed on September 28, 2005.
2. Applicants have amended the claims to cancel claims 1-20 and added new claims 21-35.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 21, 24 and 30-35 are rejected under 35 U.S.C. 102(b) as being anticipated by SCHWAHN et al. (US 2003/0140552).

SCHWAHN et al. discloses an invention related to fuel additive compositions for internal combustion engines and to fuels that contain the corresponding additives for internal combustion engines (abstract).

The fuel additive compositions preferred according to the invention comprises: an alcohol preferably ethanol (paragraph 0072); additives containing groups derived from succinic with hydroxyl and/or amido and/or imido groups are preferably corresponding derivatives of polyisobutenyl succinic anhydride having a Mn of from 150 to 5000 (paragraph 0060); polyalkenemonoamines or polyalkenepolyamines or functional derivatives thereof which can be used

according to SCHWAHN et al. are in particular poly-C2-C6-alkeneamines or functional derivatives thereof, for example based on polyethylene, polypropene, polybutene or polyisobutenes, or mixture thereof, having a Mn of 150 to 5000 (paragraph 0034 and 0036); additives containing groups produced by Mannich reaction of substituted phenols with aldehydes and mono- or polyamines (paragraph 0061); polyetheramines are poly-C2-C6-alkylene oxide amines and examples of polyalkeneamines are poly-C2-C6-alkene-amines, and functional derivatives thereof, in each case having a preferred Mn from about 150 to 5 000. The amounts of the additives in the fuel composition range from 10 to 5,000 ppm (paragraphs 0067-0068).

The gasoline fuel may furthermore have an olefin content of not more than 21, e.g. from 6 to 21, % by volume (paragraph 0070). The benzene content may be not more than 1.0, e.g. from 0.5 to 1.0, % by volume; the oxygen content may be, for example, from 0.1 to 2.7% by weight (paragraph 0072). The fuel may be, for example, a gasoline fuel having aromatics content of not more than 42, e.g. from 20 to 42% by volume (paragraph 0069). The further fuel additives which may be used and which have the polar groups are added to the fuel usually in an amount of from 10 to 5000 ppm, in particular from 50 to 1000 ppm (paragraph 0068) and a sulfur content of not more than 150 ppm (paragraph 0069), meeting the limitations of claims 24 and 30-35.

Thus the examiner is of the position that SCHWAHN et al. has met the limitations of independent claim 1 and the above rejected dependent claims.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 21-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over SCHWAHN et al. (US 2003/0140552) in view of JARVIS et al. (US 5,679,118).

SCHWAHN et al. discloses an invention related to fuel additive compositions for internal combustion engines and to fuels that contain the corresponding additives for internal combustion engines (abstract).

The fuel additive compositions preferred according to the invention comprises: an alcohol preferably ethanol; additives containing groups derived from succinic with hydroxyl and/or amido and/or imido groups are preferably corresponding derivatives of polyisobutenyl succinic anhydride having a Mn of from 150 to 5000 (paragraph 0060); polyalkenemonoamines or polyalkenepolyamines or functional derivatives thereof which can be used according to SCHWAHN et al. are in particular poly-C2-C6-alkeneamines or functional derivatives thereof, for example based on polyethylene, polypropene, polybutene or polyisobutenes, or mixture thereof, having a Mn of 150 to 5000 (paragraph 0034 and 0036); additives containing groups produced by Mannich reaction of substituted phenols with aldehydes and mono- or polyamines (paragraph 0061); polyetheramines are poly-C2-C6-alkylene oxide amines and

examples of polyalkeneamines are poly-C2-C6-alkene-amines, and functional derivatives thereof, in each case having a preferred Mn from about 150 to 5 000. SCHWAHN et al. has met the limitations of claim 21 and 25-28. Additives containing groups produced by Mannich reaction of substituted phenols with aldehydes and mono- or polyamines (paragraph 0061), meeting the limitations of claim 29.

The gasoline fuel may furthermore have an olefin content of not more than 21, e.g. from 6 to 21, % by volume (paragraph 0070). The benzene content may be not more than 1.0, e.g. from 0.5 to 1.0, % by volume; the oxygen content may be, for example, from 0.1 to 2.7% by weight (paragraph 0072). The fuel may be, for example, a gasoline fuel having aromatics content of not more than 42, e.g. from 20 to 42% by volume (paragraph 0069). The further fuel additives which may be used and which have the polar groups are added to the fuel usually in an amount of from 10 to 5000 ppm, in particular from 50 to 1000 ppm (paragraph 0068) and a sulfur content of not more than 150 ppm (paragraph 0069), meeting the limitations of claims 24 and 30-35.

SCHWAHN et al. discloses a fuel composition wherein all of the physical properties of the gasoline are present. In addition, a prima facie case of obviousness exists because the claimed ranges overlap or lie inside ranges disclosed by the prior art, see *In re Wertheim*, 541 F.2d 257, 191 USPQ 90. See MPEP 2131.03 and 2144.05.

SCHWAHN et al. does not explicitly or implicitly disclose ethanol in an amount of 20 to 75 % by volume. JARVIS et al. discloses that it is known in the art to produce high octane alcohols and a fuel composition that contains 5 to 50% ethanol, 50 to 90 % natural gasoline and 3 to 50% hydrocarbons (column 6, lines 5-10). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the various amounts of ethanol for improving the intake system-cleaning action of diverse fuels, meeting the limitations of claims 22-23.

Response to Amendment

7. The declaration under 37 CFR 1.132 filed April 30, 2009 is insufficient to overcome the rejection of claims 21-35 based upon the reference applied under 35 USC 103 as set forth in the action because: the declaration facts presented are not germane to the rejection at issue since independent claim 21 (applicants only independent claim) comprises a gasoline fuel containing ethanol in any amount. Applicants' argue that the declaration discloses combinations of additives and lower monoalcohols having a "synergistic effect" on the reduction of intake valve deposits and combustion chamber deposits. However, the results presented are not commensurate in scope with the degree of protection sought by the claims; i.e., any of the claimed conventional detergent additives in any amount and with any amount of ethanol. The claims are not limited to 50% ethanol which represents the data. Further, SCHWAHN discloses throughout the invention ways to increase performance by keeping the inlet system clean, preventing the formation of deposits, and removing deposits already present

through various detergents (paragraphs 0001-0008). Thus the examiner is of the position that results presented are not seen to be unexpected since the detergent additives of the prior art are seen to be functioning as expected.

8. Applicants' arguments filed April 30, 2009 have been fully considered but they are not persuasive.

Conclusion

9. Applicants' amendments necessitated the new ground(s) of rejection presented in this office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LATOSHA HINES whose telephone number is 571-270-5551. The examiner can normally be reached on Monday thru Thursday from 8 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ellen M McAvoy/
Primary Examiner, Art Unit 1797

/LATOSHA HINES/
Examiner, Art Unit 1797